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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,326	03/30/2004	John F. Boylan	ACSES-63439	5142
22852	7590	03/22/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			HILL, GENEVIEVE A L	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,326

Applicant(s)

BOYLAN ET AL.

Examiner

Genevieve A-L. Hill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-40, 42-64 and 69-75 is/are rejected.
- 7) ☒ Claim(s) 41, 65-68, 76 and 77 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/5/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 29-77 are objected to because of the following informalities:

"Pd" should read --palladium-- or --palladium (Pd)--

"Pt" should read --platinum-- or --platinum (Pt)--

"W" should read --tungsten-- or --tungsten (W)--

"NiTi" should read --nickel-titanium-- or --nickel-titanium (NiTi)--

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 29-30, 36-39, 42-46, 53-55, and 69-75 are rejected under 35 U.S.C. 102(e) as being anticipated by Burmeister et al (US Patent 6582461). For claims 29-30, 43-46, and 53-55, Burmeister et al disclose a tubular stent 30 composed of Ni-Ti alloy that includes additional elements such as platinum, palladium, gold, silver,

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or niobium (column 2, paragraph 5). Referring to claims 36, 42, 53, 69, and 70 the stent 30 has a superelastic layer 32 (column 5, line 51) that reaches the austenitic phase at body temperature in Figure 4a. Referring to claims 37 and 43, they also teach a stent 30 with a non-superelastic layer 34 as shown in Figure 4b. The reference highlights in Figure 2 the superelastic area; therefore, any point outside that boxed area would be in a non-superelastic phase.

For claims 38-39, since the invention is made from the same materials, it is inherently MRI compatible and radiopaque. For claims 73-75, Burmeister et al show that the alloy may also contain small amounts of other elements and can therefore inherently be a quaternary element (column 2, line 39).

3. Claims 29-40, 42-64, and 69-72 are rejected under 35 U.S.C. 102(e) as being anticipated by Boylan et al (US Patent 6572646).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

For claims 29-30, 43-46, 53-55, and 61-64, Boylan et al disclose a stent 10 with a tubular body having struts (column 5, paragraph 1) made from a nickel-titanium alloy that includes a ternary element of either palladium or platinum (column 3, paragraph 5).

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Referring to claims 31-32, 34, 47-48, 50, 56-57, 59, and 61, the composition can contain up to 10% of a ternary element (column 8, line 45), which therefore falls between 5-70%. For claims 33, 35, 49, 51, 58, and 60, the composition can *optionally* contain 3% of platinum or palladium (column 8, line 51) and therefore falls within the claimed ranges. For claim 52, the ternary element can also include up to 10% of tungsten (column 3, line 53).

Regarding claims 36, 53, and 61, the stent 10 is made from a superelastic material (column 3, line 49). For claims 38-40 and 61, the invention has radiopaque markers (column 4, line 19) and since it's made from the same materials, it is inherently MRI compatible. For claims 42 and 69-72, the stent goes into the austenitic phase at body temperature (column 3, lines 58-60). For claims 37, 43, and 63, since the stent reaches the austenitic phase at body temperature, it becomes superelastic at that point as mentioned in the previous reference (Burmeister et al). Therefore, for temperatures outside that phase, the stent will be in a non-superelastic phase.

Allowable Subject Matter

4. Claims 41, 65-68, 76-77 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Genevieve A-L. Hill whose telephone number is (571) 272-7226. The examiner can normally be reached on Monday through Friday from 9:00am to 5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GAH


David H. Willse
Primary Examiner